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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/157,998 09/22/98 LESSER

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TM02/0419

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3 CIVIC PLAZA, SUITE 210
NEWPORT BEACH CA 92660

EXAMINER

ROMAIN, J

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

04/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/157,998

Applicant(s)

Lesser

Examiner

Romain J anty

Group Art Unit

2163



☒ Responsive to communication(s) filed on Apr 2, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 40-81 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 40-81 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Objections

1. The numbering of claims 49-90 is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In the presently filed RCE dated March 2, 2001, applicant has canceled claims 1-9, 23-48 and added claims 49-90. According to CFR 1.126, misnumbered claims 49-90 have been renumbered as claims 40-81. Accordingly, claims 40-81 are pending in the instant application.

Restriction/Election

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group i. Claims 40-64 drawn to an apparatus for gathering information regarding a patient and generating a billing code related to that information, classified in class 705, subclass 2.

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Group II. Claim 65 drawn to a medical device for facilitating patient inquiries, for collecting and storing responses to said inquiries, and for generating documentation and claim requirements, classified in class 705, subclass 3.

Group III. Claim 66 drawn to a device for facilitating patients data gathering and for complying with government or insurance mandates, classified in the 705, subclass 4.

Group IV. Claim 67-81 drawn to a process for generating documents, records, and codes in compliance with government or health insurance mandates, classified in the 705, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as medical charts having at least one history, physical examination, and medical decision making information. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as algorithm for linking said stored responses and other information with government or insurance requirements and for computing codes connection with filing a claim. See MPEP § 806.05(d).

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Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as enabling a user to print or copy said final score and other gathered information to submit to said government or health insurance for payments. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and different search, restriction for examination purposes as indicated is proper.

A telephone call was made to Mark. Holland on April 11, 2001 to request an oral election to the above restriction requirement. Mark Holland alluded that he would prefer an Office action indicating the restriction.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585.

The examiner can normally be reached on weekdays from 7:30 am to 4:30 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R. Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

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April 18, 2001.


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100